



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,342	07/05/2001	Nagesh S. Kommareddi	194-12047-US	4934

24923 7590 05/26/2004

PAUL S MADAN
MADAN, MOSSMAN & SRIRAM, PC
2603 AUGUSTA, SUITE 700
HOUSTON, TX 77057-1130

EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/900,342

Applicant(s)

KOMMAREDDI ET AL.

Examiner

Tae H Yoon

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 33-39,45-56 and 61-64.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7,13-24 and 29-32.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Tae H Yoon
Primary Examiner
Art Unit: 1714

ATTACHMENT TO ADVISORY ACTION

Newly recited limitations found in the specification in claims 17 and 29 after the final rejection raise new issues that would further require search and consideration, and thus the entry of the amendment is denied.

With respect to claim 17, the recitation of the polyethylene oxide having about 100,000 weight average molecular weight only certainly at least require further consideration as well as search.

With respect to claim 29, the recited "in the absence of a carrier" clearly further require search and consideration.

With respect to claims 1-7 obvious over WO/98/16586 and to claims 1-6 anticipated by and obvious over O'Mara et al, the examiner may agree with applicant's drawing of the claimed invention when core and shell are covalently bonded and a gentle grinding method is utilized. However, the instant claim encompasses weak bonding forces such as static force or hydrogen bonding and very severe grinding method, and thus applicant's assertion has little probative value. A shell encapsulated core with weak static force would not yield the asserted continuous partial coating when very severe grinding method is used and applicant failed to show otherwise. Also, the examiner points out that the recited "(without particular materials)" is not a typo, and said particular means "certain" or "special".

With respect to claims 13-24 and 29-32 anticipated by and obvious over Kommareddi et al (US 6,126,872), applicant's amendment is the indication of the proper

Art Unit: 1714

rejection since applicant would not amend claims when the prior art has no merit.

Applicant's assertion is based on the amendment being denied of the entry and thus has no probative value. The utilization of the polyethylene oxide having molecular weight of 100,000 and up to several millions in Kommareddi et al would be an inherent practice because a lower molecular weight polyethylene oxide is sticky at room temperature due to its low melting point. The polyethylene oxide is also a drag reducer by itself, and thus the use of lower molecular weight polyethylene oxide would not be expected. One of the well known commercial chemical vendors, Aldrich Chemical Company, lists the lowest molecular weight for the polyethylene oxide as 100,000 (see attached copy) in the catalog. The examiner takes the position of the Judicial Notice.

With respect to claims 13, 15, 21, 22, 24, 29 and 31 anticipated by and obvious over Martin is maintained for reason of record and above. The instant claims recite neither polyethylene oxide nor molecular weight thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/May 19, 2004